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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO..
10/731,598	12/09/2003	Brian Jones	60001.263US01	4743
27488	7590	05/07/2007		
MERCHANT & GOULD (MICROSOFT)			EXAMINER	
P.O. BOX 2903			TRUONG, LECHI	
MINNEAPOLIS, MN 55402-0903				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/731,598	Applicant(s) JONES ET AL.	
	Examiner LeChi Truong	Art Unit 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/09/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


 WILLIAM THOMSON
 SUPERVISORY PATENT EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/08/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are presented for the examination.

Specification

2. The cross reference related to the application cited in the specification must be updated (i.e. update the relevant status, with PTO serial numbers or patent numbers where appropriated, on page 1 of the application filed on 12/09/2003).

Abstract Objected

3. The abstract of the disclosure is objected to because the abstract exceed more than 150 words in length. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-4 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.
5. Claims 1-3 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter as not being tangible because the software program product claims do not require use of hardware computer to perform, and would not result in a practical application producing a useful, concrete, an tangible result to form the basis of statutory subject matter under 35 USC 101.

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6. The language of claim 4 raises a question as to whether the claim is an abstract idea and would not result in practical application producing a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101. For example, calling the schema validation system, passing object property, that do not produce any tangible result<e.g. just a thought or just a computation within a processor which does not provide an output thereby creating a tangible result which enables the usefulness to be realized>.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of copending application serial no: 10/745164. Although the conflicting claims are not identical, they are not patentably distinct from each other because both computer systems comprise substantially the same elements. The differences between claims 1-5 of the copending application and this case are XML schema validation. It would have been obvious to one of the ordinary skill level in the

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art to include a XML schema validation since it was well known at the time of the invention to avoid errors occurred during inserting the information into the document.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (US 2003/0145197 A1) in view of Nussbaum et al (US 6,779,154 B1)

As to claim 1, Lee teaches the invention substantially as claimed including: An application programming interface (the analyzing/processing unit 150 is called, para [0032], ln 1-3, a user (user, para [0032], ln 1-3), the schema validation system (the analyzing/processing unit 150 calls the illegitimate change detecting file generating unit 160, para [0032], ln 1-3 and ln 17-22), an application programming interface for allowing a user to programmatically access the functionality of the schema validation system(para[0032], ln 1-4 and ln 17-22); a message call(calls, para[0032], ln 9-16), an file(the illegitimate change detecting information, para[0032], ln 9-17), document(documents and resources, para[0008], ln 28-32/ ln 39-43),the application programming interface comprising a message call for requesting association of an XML schema file to a document(para[0032], ln 9-17); a return value(displays the resources linked to corresponding web page to user, para[0032], ln 1-7), association of the XML schema file to the document(receives from the user interface 110 to which resource the illegitimate detecting

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information processing is performed and to which resource the encryption is applied, [0032, ln 5-10), and the application programming interface operative to receive a return value from the schema validation system responsive to association of the XML schema file to the document(para0032, ln 1-10).

Lee does not teach file as a schema XML file. However, Nussbaum teaches a schema XML file (inserts the text of the selected XML document in its entirety into the new HTML page, col 7, ln 51-54).

It would have been obvious to one of ordinary skill in the art at the invention was made to modify the teaching of Lee to incorporate the feature of schema XML because this enables the content information and linking information for an XML document during execution to be preserved for analysis using web development tools.

As to claim 2, Lee teaches said application programming interface further comprising a message call for requesting customization of one or more properties of the file (para [0032], ln 9-17); and the application programming interface further operative to receive return value from the schema validation system responsive to the message call for requesting customization of the one or more properties of the file (para [0032], ln 1-15).

As to claim 3, it is an apparatus claim of claims 1, 2; therefore, it is rejected for the same reasons as claims 1, 2 above. In addition, Lee teaches providing one or mere parameter (receives from the user interface unit 110 to which resource the illegitimate change detecting information, para [0032], ln 6-10).

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10. Claims **4, 21, 24** are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lee at al (US 2003/0145197 A1) in view of Robetson et al (US 2004/0103369 A1).

As to claim **4**, Lee calling the schema validation system (para [0032], ln 1-17, object property (resource, para [0032], ln 1-10/ the various resources including XML, HTML, XHTML document, texts, para [0030], ln 5-10), passing an object property to the schema validation system (the analyzing/processing unit 150 receives from the user interface unit 1100 to which resource the illegitimate change detecting information process is performed, and to which resource the encryption is applied, para [0032], a software object(the ciphertext generating unit 130, 140, para[0032], ln 6-14, the object property being associated with a software object associated with the functionality of the schema validation system(para[0032], ln 6-117); and in response to the message call (para [0032], ln 1-3), and the object property passed to the schema validation system (para [0032], ln 6-10), receiving access to a functionality of the schema validation system associated with the object property passed to the schema validation system (para [0032], ln 1-17).

Lee does not teach an object-oriented message call. However, Robertson teaches an object-oriented message call (a library file contain various object-oriented code that implement many of the features available for display and editing of data by conventional client-side software... function calls to the library file for object-oriented code used to display and allow edits to a table display to a user, para [0109], ln 1-10).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the teaching Lee to incorporate the feature of an object-oriented message

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call because this allows a user to delete and insert rows, add and edit data in the web page based tables.

As to claim 21, Robertson teaches removing a schema file reference from a document and for removing the XML schema file reference from a schema file references collection (para [0019], ln 13-18).

As to claim 24, Robertson teaches for re-associating a specified schema file with a document where the specified schema file was previously removed from association with the document (para [0109], ln 7-10).

11. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (US 2003/0145197 A1) in view of Robertson et al (US 2004/0103369 A1) and further in view of Nussbaum et al (US 6,779,154 B1)

As to claim 5, Lee teaches passing a child not suggestions property for obtaining a list of all file associated with a document and based on editing context within the document (para [0030], ln 4-12/ para [0006], ln 1-6/ left col 9, ln 25-41).

Lee and Robertson do not teach file as a schema XML file. However, Nussbaum teaches a schema XML file (inserts the text of the selected XML document in its entirety into the new HTML page, col 7, ln 51-54).

It would have been obvious to one of ordinary skill in the art at the invention was made to modify the teaching of Lee and Robertson to incorporate the feature of schema XML because

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this enables the content information and linking information for an XML document during execution to be preserved for analysis using web development tools.

As to claim 6, Lee teaches passing an object property to the schema validation system includes passing an object property for returning a list of all XML schema files associated with a document (para [0032], ln 1-10)

As to claim 7, Lee teaches document associated with an XML schema violation based on an associated XML schema file (para [0052], ln 11-15)...

As to claim 8, Lee teaches passing an object property to the schema validation system includes passing an object property for determining a format of error messages presented by the schema validation system related to schema file validations (para [0053], ln 8-16)

As to claim 9, it is an apparatus claim of claim 5; therefore, it is rejected for the same reason as claim 5 above.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (US 2003/0145197 A1) in view of Robetson et al (US 2004/0103369 A1) and further in view of Shin (system and method for offering advertisement on space of cyber document).

As to claim 10, Lee teaches passing an object property to the schema validation system includes passing an object method for inserting an XML element into a document (para [0032], ln 9-17).

Lee and Robetson do not teach a range parameter for pointing to a part of the document where the element is to be inserted. However Shin teaches a range parameter for pointing to a

part of the document where the element is to be inserted (checking if the tag is related to a character or an image (S130), in a case of a character, the characters and image processor calculating a length of the characters, page 2, 12-16).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the teaching of Lee and Robetson to incorporate the feature of a range parameter for pointing to a part of the document where the element is to be inserted because this provides a system for inserting advertisement into vacant space of web documents so that is enhance an advertisement effect.

13. Claims **11-20, 22, 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee at al (US 2003/0145197 A1) in view of Robetson et al (US 2004/0103369 A1) and further in view of Manning et al (US 2002/0103829 A1).

As to claim 11, Lee and Robetson do not teach returning a uniform Resource identifier identifying an XML schema file associated with the XML element Inserted into the document. However, Manning teaches returning a uniform Resource identifier identifying an XML schema file associated with the XML element Inserted into the document(provides the name of the root element for that document that providing a unique identifier for the XML document, col 2, ln 37-40).

It would have been obvious to one the ordinary skill in the art at the time the invention was made to modify the teaching of Lee and Robetson to incorporate the feature of returning a uniform Resource identifier identifying an XML schema file associated with the XML element

inserted into the document because this allows to search on objects in the structured documents using the database system facilities.

As to claim 12, Lee teaches passing an object property to the schema validation system includes passing an object method for customizing schema validation error notifications from the schema validation system (para [0053], ln10-17).

As to claim 13, Lee teaches passing an object method for requesting validation of a specified XML element applied to a document (para [0032], ln 17-22/ para [0035], ln 1-14).

As to claim 14, Lee teaches passing an object property to the schema validation system includes passing an object property for returning a description text of a specified XML schema violation for a specified XML element applied to a document (para [0053], ln 10-17).

As to claim 15, Lee teaches passing an object method for attaching users specified XML schema file to a document (para [0032], ln 1-17).

As to claim 16, Lee teaches directing the schema validation system to allow saving a document as an XML document where saving the document as an XML document violates an associated XML schema file (para [0032], ln 1-17).

As to claim 17, Lee teaches passing an object property to the schema validation system includes passing an object property for causing the schema validation system to allow mixed content data entry into a document (para [0031], ln 10-16), where the mixed content data entry otherwise violates an associated XML schema file (para [0053], ln 10-17).

As to claim 18, Lee teaches accessing a specified XML schema file associated with a document from a collection of XML schema file references whereby a parameter associated with

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the specified XML schema reference is passed to the schema validation system with the object method (para [0032], ln 1-17).

As to claim 19, Lee teaches controlling whether XML schema violations are highlighted in a document by the schema validation system (para [0053], ln 10-17).

As to claim 20, Lee teaches schema validation system includes passing an object method requiring the schema validation system to validate a document against all XML schema files associated with the document (para [0032], ln 17-22/ para [0035], ln 1-17).

As to claim 22, Manning teaches returning a location of a specified file (para [0022], ln 36-40).

As to claim 23, Manning teaches returning a Namespace uniform resource identifier associated with a specified file (para [0022], ln 36-40).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LeChi Truong whose telephone number is (571) 272 3767. The examiner can normally be reached on 8 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomson, William can be reached on (571) 272 3718. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

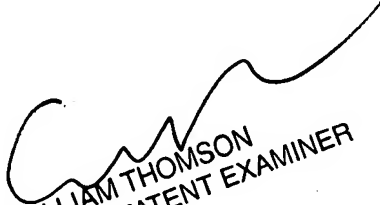
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LeChi Truong

April 27, 2007


WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER